MOHD SYAMSUL MD YUSOF & ORS v. ELIAS IDRIS

FEDERAL COURT, PUTRAJAYA
DAVID WONG DAK WAH CJ (SABAH & SARAWAK)
RAMLY ALI FCJ
MOHD ZAWAWI SALLEH FCJ
IDRUS HARUN FCJ
NALLINI PATHMANATHAN FCJ
[CIVIL APPEAL NO: 02(f)-63-08-2018(W)]
27 MARCH 2019

INTELLECTUAL PROPERTY: *Copyright – Infringement – Allegation by author of novel that substantial parts of novel taken for production of movie – Test for infringement of copyright – Whether novel fell under 'literary work' – Whether literary work eligible for copyright – Onus on author – Whether author established element of objective similarity between novel and movie – Copyright Act 1987, ss. 3, 7(1)(a) & (3)*

CIVIL PROCEDURE: *Courts – Court of Appeal – Appeal from High Court – Action for infringement of copyright – Court of Appeal reversed and set aside findings of High Court – Whether judgment indicated that Court of Appeal examined and evaluated evidence adduced by parties during trial – Whether findings and conclusion of High Court plainly wrong – Whether reversal and setting aside of decision justified*

The respondent ('plaintiff'), the author of the novel 'Aku Bohsia' which was published in 1995 ('the novel'), claimed to be the copyright owner of the novel and claimed for its protection under the Copyright Act 1987 ('the Act'). The first appellant ('first defendant') was the lead actor, lead scriptwriter and director of the movie 'Bohsia: Jangan Pilih Jalan Hitam' ('the movie'), whilst the second appellant ('second defendant') was the producer and the third appellant ('third defendant') was the distributor of the movie. The plaintiff filed an action, at the High Court, against the defendants for copyright infringement contending that the defendants had taken, without his consent, several of the novel's contents, themes, plots, and characters for the production of the movie. The plaintiff, among others, sought to stop the distribution of the movie, as well as the damages and financial returns enjoyed by the defendants because of the alleged infringement. The defendants denied basing the movie on the novel and averred that they had never read or even heard of the novel, and that there were many dissimilarities between both works; and any similarity was purely coincidental due to the similarity of ideas as both involved the common social issues involving 'bohsia' girls. The defendants thus filed a counterclaim against the plaintiff over defamatory articles published in his blog. The defendants claimed that the articles had tarnished their reputation; and sought general and exemplary damages as well as an injunction to restrain the plaintiff from making statements implying that they had copied

his novel. Having considered all the relevant evidence relating to similarities and dissimilarities between both works, the High Court dismissed the plaintiff's claim for copyright infringement and allowed the defendants' counterclaim for defamation. However, upon appeal, the Court of Appeal set aside the decision of the High Court holding that there were substantial similarities between both works and the similarities were not 'merely coincidental' and mere 'similarities in ideas.' The Federal Court granted leave to appeal to the defendants on the following questions of law: (i) was publication itself sufficient satisfaction to the legal requirement of causal connection in order to succeed in a claim on infringement of copyright ('question 1'); and (ii) in carrying out the test in *Megnaway Enterprise Sdn Bhd v. Soon Lian Hock* ('*Megnaway*'), was there a legal duty for the court to examine and evaluate both the distinct materials being the subject matter under the claim on infringement of copyright ('question 2').

Held (allowing appeal with costs; setting aside decision of Court of Appeal and affirming and reinstating decision of High Court)
Per Ramly Ali FCJ delivering the judgment of the court:

(1) An act of infringement or copying of copyright work by an alleged infringer, involves two basic elements which must be established by the copyright owner, namely: (i) sufficient degree of objective similarity between the two works; and (ii) some causal connection between the copyright work and the alleged infringing work. Neither the intention to infringe, nor knowledge that he is infringing on the part of the defendant, is a necessary ingredient in the cause of action for infringement of copyright. Once the two elements of sufficient objective similarity and causal connection are established, it is no defence that the defendant was unaware that what he was doing infringed copyright of the plaintiff's work. (paras 17 & 19)

(2) In an action for an infringement of copyright, the court must first identify the features of the defendants' movie that the plaintiff alleged to have been copied from his novel. The test of copying was that the similarities of the features came so near to the original as to suggest that the features in the infringing work were the original to the mind of every person seeing it. Whether or not there had been an infringement, must be a matter of degree, depending on the facts and circumstances of the case. (paras 21 & 22)

(3) The elements and necessary tests outlined in *Megnaway* were: (i) there was sufficient objective similarity between the original work or a substantial part thereof, and the infringing copy; (ii) there was a causal connection between the original work and the infringing copy, *ie*, the infringing copy must have been copied from the original work, whether directly or indirectly; and (iii) what had been infringed must constitute a substantial part of the original work. The plaintiff's novel fell under the category of '*literary work*' as defined under s. 7(1)(a) read with s. 3

of the Act. Section 7(3) provides that a literary work shall not be eligible for copyright unless sufficient effort has been expended to make the work original in character; and the work has been written down, recorded, or otherwise reduced to material form. The onus was on the plaintiff to prove, on a balance of probabilities, that there was sufficient objective similarity or similarities between the novel and the movie. (paras 26, 28 & 29)

(4) The High Court, upon examining and evaluating the relevant evidence, found that the plaintiff had failed to establish the element of objective similarity between the novel and the movie to support the claim for copyright infringement. The question of objective similarity between the two works in question and its substantiality could only be determined by direct comparison between the two works. The Court of Appeal reversed and set aside the findings of fact on the issue of similarities made by the High Court 'on a careful comparison of the similarities enumerated in para. 10 of the plaintiff's statement of claim'. Nowhere in the Court of Appeal's judgment was it indicated that the Court of Appeal had examined and evaluated the evidence available as adduced by both parties during trial. (paras 32, 38, 40 & 43)

(5) There was nothing to show that the findings and conclusion arrived at by the High Court, on the balance of probabilities, were plainly wrong to justify such findings and conclusion to be reversed and set aside by the Court of Appeal. Therefore, the findings and the decision of the Court of Appeal could not stand and ought to be set aside. In the circumstances, question 2 was answered in the affirmative, in that, there was a legal duty for the court to examine and evaluate both the distinct materials being the subject matter under the claim of infringement of copyright. Without substantial objective similarity between the novel and the movie, the first requirement or element as outlined in *Megnaway* had not been established by the plaintiff. In the premise, there was no necessity to answer question 1 on the issue of causal connection. The issue of causal connection arose only after the issue of substantial similarity between the two works had been established. (paras 45-48)

Bahasa Malaysia *Headnotes*

Responden ('plaintif'), penulis novel 'Aku Bohsia' yang diterbitkan pada 1995 ('novel'), menuntut milikan hak cipta dan memohon perlindungan bawah Akta Hak Cipta 1987 ('Akta'). Perayu pertama ('defendan pertama') ialah pelakon utama, penulis skrip utama dan pengarah filem 'Bohsia: Jangan Pilih Jalan Hitam' ('filem'), sementara perayu kedua ('defendan kedua') ialah penerbit dan perayu ketiga ('defendan ketiga') ialah pengedar filem itu. Plaintif memfailkan satu tindakan, di Mahkamah Tinggi, terhadap defendan-defendan untuk pelanggaran hak cipta dengan menghujahkan bahawa defendan-defendan telah mengambil, tanpa persetujuannya, beberapa kandungan, tema, plot dan watak-watak novel tersebut untuk pengeluaran

filem itu. Plaintif, antara lain, memohon untuk menghentikan pengedaran filem tersebut, serta ganti rugi dan pulangan kewangan yang dinikmati defendan-defendan daripada pelanggaran yang didakwa. Defendan-defendan menafikan mendasari filem itu atas novel dan menyatakan bahawa mereka tidak pernah membaca mahupun mendengar tentang novel itu, dan terdapat banyak ketidakpersamaan antara kedua-dua karya tersebut; dan apa-apa persamaan adalah kebetulan semata-mata disebabkan persamaan idea kerana kedua-duanya melibatkan isu-isu sosial umum melibatkan gadis-gadis 'bohsia'. Defendan-defendan, dengan itu, memfailkan tuntutan balas terhadap plaintif untuk artikel-artikel memfitnah di blognya. Defendan-defendan menyatakan bahawa artikel-artikel tersebut mencemarkan reputasi mereka; dan memohon ganti rugi am dan teladan serta injunksi menghalang plaintif membuat kenyataan-kenyataan yang membayangkan mereka meniru novel plaintif. Selepas mempertimbangkan kesemua keterangan relevan tentang persamaan dan perbezaan antara kedua-dua karya, Mahkamah Tinggi menolak tuntutan plaintif untuk pelanggaran hak cipta dan membenarkan tuntutan balas defendan-defendan untuk fitnah. Walau bagaimanapun, Mahkamah Rayuan mengetepikan keputusan Mahkamah Tinggi memutuskan bahawa terdapat persamaan besar antara kedua-dua karya dan persamaan tersebut bukan 'kebetulan semata-mata' dan hanya 'persamaan idea'. Mahkamah Persekutuan memberi kebenaran untuk merayu kepada defendan-defendan atas soalan undang-undang berikut: (i) adakah penerbitan itu sendiri secukupnya memenuhi keperluan undang-undang hubungan penyebab untuk berjaya dalam tuntutan pelanggaran hak cipta ('soalan 1'); dan (ii) dalam melaksanakan ujian dalam kes *Megnaway Enterprise Sdn Bhd v. Soon Lian Hock* ('*Megnaway*'), sama ada terdapat kewajipan dari segi undang-undang untuk mahkamah memeriksa dan menilai kedua-dua bahan yang berbeza itu sebagai perkara bawah tuntutan pelanggaran hak cipta ('soalan 2').

Diputuskan (membenarkan rayuan dengan kos; mengetepikan keputusan Mahkamah Rayuan dan mengesahkan dan mengembalikan semula keputusan Mahkamah Tinggi)

Oleh Ramly Ali HMP menyampaikan penghakiman mahkamah:

(1) Tindakan pelanggaran atau peniruan karya yang mempunyai hak cipta oleh pelanggar yang didakwa melibatkan dua ciri-ciri asas yang mesti dibuktikan oleh pemilik hak cipta, iaitu: (i) tahap persamaan objektif yang mencukupi antara kedua-dua karya; dan (ii) hubungan penyebab antara karya hak cipta dan karya yang didakwa melanggar. Niat untuk melanggar, mahupun pengetahuan defendan bahawa dia melanggar, bukan unsur yang diperlukan dalam kausa tindakan pelanggaran hak cipta. Jika kedua-dua elemen persamaan objektif yang mencukupi dan hubungan penyebab dibuktikan, defendan tidak boleh bersandar pada pembelaan bahawa dia tiada pengetahuan apa-apa yang dilakukannya melanggar hak cipta karya plaintif.

(2) Dalam tindakan pelanggaran hak cipta, mahkamah mesti pertama sekali mengenal pasti ciri-ciri filem defendan-defendan yang didakwa plaintif ditiru daripada novelnya. Ujian untuk peniruan adalah persamaan ciri-ciri adalah amat dekat dengan yang asal sehingga mencadangkan bahawa ciri-ciri dalam karya yang melanggar wujud dalam fikiran setiap orang yang menontonnya. Sama ada atau tidak terdapat pelanggaran, adalah perkara melibatkan tahap, yang bergantung pada fakta-fakta dan hal keadaan kes.

(3) Elemen-elemen dan ujian-ujian yang perlu yang dinyatakan dalam *Megnaway* adalah: (i) terdapat persamaan objektif yang mencukupi antara karya asal atau sebahagian besar daripadanya, dan karya yang melanggar; (ii) terdapat hubungan penyebab antara karya asal dan karya yang melanggar, iaitu, karya yang melanggar mesti telah ditiru daripada karya asal, sama ada secara langsung atau tidak langsung; dan (iii) apa yang dilanggar mesti membentuk sebahagian besar karya asal. Novel plaintif terangkum bawah kategori 'karya sastera' seperti yang ditafsir bawah s. 7(1)(a) dibaca bersama-sama dengan s. 3 Akta. Seksyen 7(3) memperuntukkan bahawa sesuatu karya sastera tidak layak mendapat hak cipta melainkan usaha yang mencukupi dilakukan untuk menjadikan kerja itu bersifat asli; dan karya itu telah ditulis, direkod atau selainnya dijadikan dalam bentuk bahan. Beban terletak pada plaintif untuk membuktikan atas imbangan kebarangkalian bahawa terdapat persamaan objektif yang mencukupi atau persamaan-persamaan antara novel dan filem tersebut.

(4) Mahkamah Tinggi, selepas memeriksa dan menilai keterangan relevan, mendapati plaintif gagal membuktikan elemen persamaan objektif antara novel dan filem tersebut untuk menyokong tuntutan untuk pelanggaran hak cipta. Soalan persamaan objektif antara kedua-dua karya dalam persoalan dan kecukupbesaran hanya boleh ditentukan melalui perbandingan langsung antara kedua-dua karya. Mahkamah Rayuan, mengakas dan mengetepikan dapatan-dapatan fakta atas isu persamaan yang dibuat Mahkamah Tinggi 'on a careful comparison of the similarities enumerated in para 10 of the plaintiff's statement of claim'. Tiada di mana-mana dalam penghakiman Mahkamah Rayuan dinyatakan bahawa Mahkamah Rayuan telah memeriksa dan menilai keterangan sedia ada seperti yang dikemukakan oleh kedua-dua pihak semasa perbicaraan.

(5) Tiada apa-apa untuk menunjukkan bahawa dapatan-dapatan dan keputusan yang dicapai Mahkamah Tinggi, atas imbangan kebarangkalian, jelas salah untuk menjustifikasi dapatan-dapatan dan keputusan itu diakas dan diketepikan oleh Mahkamah Rayuan. Oleh itu, dapatan-dapatan dan keputusan Mahkamah Rayuan tidak boleh dikekalkan dan wajar diketepikan. Dalam hal keadaan tersebut, soalan 2 dijawab secara afirmatif, iaitu, terdapat kewajipan dari segi undang-

undang untuk mahkamah memeriksa dan menilai kedua-dua bahan yang berbeza yang menjadi perkara bawah tuntutan pelanggaran hak cipta. Tanpa persamaan objektif besar antara novel dan filem tersebut, keperluan atau elemen pertama seperti yang dinyatakan dalam *Megnaway* tidak dibuktikan oleh plaintif. Berikutan itu, tiada keperluan untuk menjawab soalan 1 atas isu hubungan penyebab. Isu hubungan penyebab hanya timbul selepas isu persamaan besar antara kedua-dua karya dibuktikan.

Case(s) referred to:

Designer Guild Ltd v. Russell Williams (Textiles) Ltd (2000) All ER (D) 1950 ***(refd)***

Francis Day & Hunter v. Bron [1963] Ch 587 ***(refd)***

L Mulkh Raj Sharma v. Shanti Sroop [1984] 1 CLJ 24; [1984] 1 CLJ (Rep) 277 FC ***(refd)***

Megnaway Enterprise Sdn Bhd v. Soon Lian Hock (No 2) [2009] 8 CLJ 130 HC ***(refd)***

Purefoy Engineering Co Ltd and Another v. Sykes Boxall & Co Ltd and Others [1955] 72 RPC 89 ***(refd)***

Stesin Pty. Ltd & Another v. Johnson & Others [1995] 291 PR 461 ***(refd)***

Legislation referred to:

Copyright Act 1987, ss. 3, 7(1)(a), (3), 36(1), (2)

For the appellants - Haniff Khatri Abdulla, Aizul Rohan Anuar, Saiful Dzulhelmi & Muhammad Rafique Rashid Ali; M/s Saiful, Roger & Co

For the respondent - Periasamy Karuppan & Abd Razak Ismail; M/s Periasamy & Co

[Editor's note: For the Court of Appeal judgment, please see Elias Idris v. Mohd Syamsul Md Yusof & Ors [2018] 1 LNS 1029 (overruled); For the High Court judgment, please see [2016] 1 LNS 1190 (affirmed).]

Reported by S Barathi

JUDGMENT

Ramly Ali FCJ:

[1] The appellants in the present appeal were the defendants at the High Court and the respondent was the plaintiff there. The plaintiff's cause of action against the defendants is based on copyright infringement. The High Court dismissed the plaintiff's claim. On appeal, the Court of Appeal allowed the appeal and set aside the order of the High Court. Hence, the present appeal before us. We heard and allowed the appeal on 27 March 2019. We will now give our grounds for the decision. For ease of reference, parties will be referred to as they were in proceedings before the High Court: ie, the appellants as the defendants, and the respondent as the plaintiff.

Leave Questions

[2] On 24 July 2018, the Federal Court granted leave to appeal to the defendants on the following questions of law:

(i) Is publication itself sufficient satisfaction to the legal requirement of causal connection in order to succeed in a claim on infringement of copyright (question 1); and

(ii) In carrying out the test in *Megnaway Enterprise Sdn Bhd v. Soon Lian Hock (No 2)* [2009] 8 CLJ 130; [2009] 3 MLJ 525, is there a legal duty for the court to examine and evaluate both the distinct materials being the subject matter under the claim on infringement of copyright. (question 2).

Brief Facts

[3] The plaintiff is the author of the novel "Aku Bohsia", which was published in 1995 by Kreatif Akademik (the novel). He claimed to be the copyright owner of the said novel and claimed for its protection under the Copyright Act 1987 (the Act).

[4] The first defendant was the lead actor, lead scriptwriter, and director of the movie "Bohsia: Jangan Pilih Jalan Hitam (the movie)". The second defendant, the father of the first defendant, was the producer of the movie. The third defendant was the distributor of the movie.

[5] The plaintiff filed the present action in the High Court, against the defendants for copyright infringement in that the defendants had taken, without his consent, several of the novel's contents, themes, plots, and characters for the production of the movie. The plaintiff, among others, had sought to stop the distribution of the movie, damages and financial returns enjoyed by the defendants because of the alleged infringement.

[6] The defendants, in their statement of defence, denied basing the movie on the novel. They averred that they had never read or even heard of the novel, and that there were many dissimilarities between both works; and any similarity was purely coincidental due to similarity of ideas as both involved the common social issues involving 'bohsia' girls.

[7] The defendants also filed a counterclaim against the plaintiff over his defamatory articles published in his blog on 7 December 2014 and 16 November 2014. The defendants claimed that the articles had tarnished their reputation; and sought for general and exemplary damages as well as an injunction to restrain the plaintiff from making statements implying that they had copied his novel.

At The High Court

[8] The High Court dismissed the plaintiff's claim for copyright infringement and allowed the defendants' counterclaim for defamation. The learned judge found that the similarities alleged between the novel and the movie were not the result of copying, as both works discussed the 'bohsia'

phenomenon and the issue of 'mat rempit' which were common social issues that existed even before the novel's publication and continued to be relevant even today.

[9] From the records and notes of evidence adduced by both parties during trial, the learned judge had apparently considered all the relevant evidence relating to similarities and dissimilarities between both works in coming to her decision in favour of the defendants. At paras. [42] and [43] of her judgment, the learned judge ruled:

> [42] I am of the considered opinion that from the above evidence of the plaintiff and the defendants, it clearly shows that 'bohsia', commonly associated with 'mat rempit' are also associated with social problems ('berfoya-foya', 'melepak'), loose moral values such as sexual activities ('kegiatan maksiat') and involvement in drugs and liquor.
>
> [43] "Bohsia" and its related social problems and common features are already part of our society before the publication of the plaintiff's novel in 1995 and persisted until today. All these elements associated with 'bohsia', which are part of our social problems, are therefore information that is both commonplace and general ideas in our society that cannot form part the comparison between the novel and the movie. The 'bohsia' and 'mat rempit' issues are general issues which are already in public domain that cannot be said to be exclusive only to the plaintiff's novel. The 'bohsia' issue is already a part of our society that it was included in the national dictionary.

[10] In her evaluation of the evidence, the learned judge made comparison between the novel and the movie. In doing so, she had excluded ideas and elements associated with 'bohsia' which are both commonplace and general ideas in society. Thus, similarities as alleged by the plaintiff in items 1 (b-e), 4, 8, 9, 10, 11, 12, 13 and 14 in his evidence were excluded from comparison.

[11] After excluding the elements and ideas of commonplace and general ideas, the learned judge then ruled as follows:

> [46] As such, and after taking out the ideas and elements associated with 'bohsia', what are left for comparison are the similarities in the scene of the rape of the daughter by her father, the relationship between the daughter and her mother, the names of the character, and the places of gathering of the 'bohsia' and 'mat rempit (similarities in item 1/a, 3, 5, 6, and 15)'. However, I am of the considered opinion that by themselves, they cannot be said to be substantial similarities that goes to the root of the novel and the movie. The root of both the novel and the movie are the social issues surrounding the 'bohsia' and to a lesser extent, the 'mat rempit'.

[12] Based on the whole evidence adduced during trial, the learned judge ruled that the plaintiff had failed to establish the element of substantial similarities and the causal connection between the novel and the movie to enable the court to say that the movie was copied from the novel.

[13] In respect of the two articles published on the plaintiff's blog with regard to the defendants' counterclaim, the learned judge found that the defendants had established their counterclaim against the plaintiff in defamation and awarded the defendants damages in the sum of RM100,000.

At The Court Of Appeal

[14] On appeal, the Court of Appeal allowed the appeal, reversed, and set aside the decision of the High Court. The Court of Appeal held that there were substantial similarities between both works that were not "merely coincidental" and mere "similarities in ideas." The similarities between the novel and the movie were so numerous and related not just to the general theme, plots, names of characters and places, but more importantly, character traits - even specific events and relationships in the lives of the characters. The similarities between the novel and the movie were too numerous and cumulatively could not be termed as "commonplace, unoriginal or consist of general ideas". The movie had essentially reproduced the novel.

[15] The Court of Appeal concluded that the defendants had infringed the plaintiff's copyright to his novel and therefore the defendants' counterclaim was not sustainable. The Court of Appeal further granted the plaintiff an injunction order to prevent the defendants, or their agent, from further publishing, broadcasting, distributing, and reproduction of the movie without the plaintiff's written consent; and to deliver all infringed copies to the plaintiff. The Court of Appeal also ordered for accounts to be taken to identify profits received from the alleged infringement and movies to be paid to the plaintiff.

Our Decision

[16] In law, the owner of a copyright work (such as the novel in the present case) has an exclusive right to control the reproduction of the whole work or a substantial part thereof in Malaysia. Under s. 36(1) of the Copyright Act 1987, "copyright is infringed by any person who does or causes any other person to do, without the licence or consent of the owner of the copyright, an act the doing of which is controlled by copyright under the Act." Under s. 36(2), copyright is infringed by any person:

(i) by selling, letting for hire, or by way of trade, offering or exposing for sale or hire, the article;

(ii) by distributing the article:

(a) for the purpose of trade; or

(b) for any other purpose to an extent that it will affect prejudicially the owner of the copyright; or

(iii) by way of trade, exhibiting the article in public; where he knows or ought reasonably to know that the making of the article was carried out without the consent or licence of the owner of the copyright.

[17] Based on well-settled authorities, an act of infringement or copying of copyright work by an alleged infringer, involves two basic elements which must be established by the copyright owner, namely:

(i) sufficient degree of objective similarity between the two works; and

(ii) some causal connection between the copyright work and the alleged infringing work.

The degree of objective similarity must be substantial. Once element (i) is established, on the balance of probabilities, the burden is shifted to the alleged infringer to refute by evidence, also on the balance of probabilities, that there was no copying but independent creation, dispute the similarity.

[18] Diplock LJ in the case of *Francis Day & Hunter v. Bron* [1963] Ch 587, had precisely explained the principle in determining whether an infringement of copyright has occurred. At p. 623 of the report, His Lordship held:

> Nevertheless, it is well established that to constitute infringement of copyright in any literary, dramatic or musical work, there must be present two elements: first, there must be sufficient objective similarity between the infringing work and the copyright work, or a substantial part thereof, for the former to be properly described, not necessarily as identical with, but as a reproduction or adaptation of the latter, secondly, the copyright work must be the source from which the infringing work is derived.

[19] In the same case, Diplock LJ expressed his view that it is equally clear law that neither intention to infringe, nor knowledge that he is infringing on the part of the defendant, is a necessary ingredient in the cause of action for infringement of copyright. Once the two elements of sufficient objective similarity and causal connection are established, it is no defence that the defendant was unaware (and could not have been aware) that what he was doing infringed copyright of the plaintiff's work.

[20] The determination of the elements as outlined in *Francis Day (supra)*, ie, sufficient objective similarity and causal connection between the two works is a question of fact and the burden is on the plaintiff to establish those ingredients by evidence. Proof of both the above elements that give rise to an inference that the defendants had copied the plaintiff's work is to be rebutted by the defendants. The burden then shifts to the defendants to show there was an independent creation of the movie.

[21] In an action for an infringement of copyright, as in the present case, the court must first identify those features of the defendants' movie that the plaintiff alleged to have been copied from his novel. The court undertakes full comparison of the two works, noting the similarities and the differences. This is to determine whether the particular similarities relied on by the

plaintiff are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are commonplace, unoriginal or consist of general ideas. As aptly laid down in *Designer Guild Ltd v. Russell Williams (Textiles) Ltd* (2000) All ER (D) 1950, the copyright owner must demonstrate sufficient similarity, in the features which he alleged have been copied and that the defendant had prior access of his copyright work. (see: *Designer Guild Ltd v. Russell Williams (Textiles) Ltd* (2000) All ER (D) 1950).

[22] The question as to whether the defendant has copied the plaintiff's work can generally and effectively be answered merely by a comparison of the two works in respect of all essential or features. Here, a useful test of copying is that the similarities of the features, come so near to the original as to suggest that the features in the infringing work are the original to the mind of every person seeing it. Whether or not there has been an infringement must be a matter of degree, depending on the facts and circumstances of the case. As precisely said by Upjohn LJ in *Francis Day (supra)*, "this is really a question of fact and nothing else which depends on the circumstances of each case."

[23] The first question to be asked by the court is whether in fact the alleged infringing work is similar or substantially similar to the copyright work. The next question is whether has the defendants copied the plaintiff's work or is it an independent work of his own. The degree of objective similarity in each case needs to be evaluated from the evidence to determine the issue.

[24] "The degree of objective similarity is, of course, not merely important, indeed essential, in proving the first element in infringement, namely, that the defendant's work can properly be described as a reproduction or adaptation of the copyright work; it is also very cogent material from which to draw the inference that the defendant has in fact copied, whether consciously or unconsciously, the copyright work." (per Diplock LJ in *Francis Day & Hunter (supra)* at p. 627; see also: *Stesin Pty Ltd & Another v. Johnson & Others* [1995] 291 PR 461).

[25] For the purpose of this judgment and to determine the elements of similarities, we will deal with question 2 first. Question 2 relates to the test in *Megnaway Enterprise Sdn Bhd v. Soon Lian Hock (No 2)* [2009] 8 CLJ 130 [2009] 8 CLJ 130; [2009] 3 MLJ 525: whether there is a legal duty for the court to examine and evaluate both the distinct materials being the subject matter under the claim of infringement of copyright?

[26] The issue of direct infringement of copyright, the elements and necessary tests outlined in *Megnaway Enterprise (supra)*, adopting the elements set out in *Purefoy Engineering Co Ltd and Another v. Sykes Boxall & Co Ltd and Others* [1955] 72 RPC 89, are as follows:

(i) there is sufficient objective similarity between the original work or a substantial part thereof, and the infringing copy;

(ii) there is a causal connection between the original work and the infringing copy, that is the infringing copy must have been copied from the original work, whether directly or indirectly; and

(iii) what has been infringed must constitute a substantial part of the original work.

[27] In order to effectively determine the above elements (particularly elements (i) and (iii)), legal authorities point to the requirement that it is the duty of the court to examine and evaluate, on evidence, the distinct materials and features of both works in question. Only with such examination and evaluation, the court will be able to make a good comparison to determine the similarities and differences between the two works. Such examination and evaluation must be done on the evidence adduced in court, either in the form of oral testimonies or documents, but not merely on the statement of claim or pleadings (as the statement of claim and pleadings are not evidence, thus cannot establish any factual proof).

[28] In the present case, it is not in dispute that the plaintiff's novel falls under the category of "literary work" as defined under s. 7(1)(a) read with s. 3 of the Act. Section 7(3) provides that a literary work shall not be eligible for copyright unless sufficient effort has been expended to make the work original in character; and the work has been written down, recorded, or otherwise reduced to material form.

[29] The plaintiff submitted that the defendants had "lifted, utilised, copied, and plagiarised the contents, theme, plot, characters, and message in the novel to create, produce, and distribute the movie." Therefore, based on established authorities, the onus is on the plaintiff to prove on balance of probabilities that there is sufficient objective similarity or similarities between the novel and the movie. If that burden is discharged, only then the court may proceed to consider the element of causal connection between the two works.

[30] In the present case, in her attempt to decide on objective similarities between the novel and the movie, the learned judge had firstly, identified 15 alleged similarities gathered from the testimonies adduced by the plaintiff and his witnesses during trial (as listed in items 1 - 15, at pp. 15 - 21 of the High Court judgment). However, from that number, the learned judge had excluded the alleged similarities in items (2), (7) and (10) on the ground that they were not pleaded in the statement of claim.

[31] The learned judge then went on to consider the other alleged similarities. Guided by the principle laid by the House of Lords in *Designers Guild Ltd (supra)*, the learned judge had disregarded and excluded the alleged similarities in items 1 (b - e), 4, 8, 9, 11, 12, 13 and 14 on the ground that

they relate to features that are both commonplace and general ideas in our society that cannot form part of the comparison between the novel and the movie. This is clear from the relevant paragraphs of the judgment:

> [42] I am of the considered opinion that from the above evidence of the plaintiff and the defendants, it clearly shows that 'bohsia', commonly associated with 'mat rempit' are also associated with social problems ('berfoya-foya', 'melepak'), loose moral values such as sexual activities ('kegiatan maksiat') and involvement in drugs and liquor.
>
> [43] "Bohsia" and its related social problems and common features are already part of our society before the publication of the Plaintiff's novel in 1995 and persisted until today. All these elements associated with 'bohsia', which are part of our social problems, are therefore information that is both commonplace and general ideas in our society that cannot form part the comparison between the novel and the movie. The 'bohsia' and 'mat rempit' issues are general issues which are already in public domain that cannot be said to be exclusive only to the plaintiff's novel. The 'bohsia' issue is already a part of our society that it was included in the national dictionary.
>
> [44] Therefore, bearing in mind that both the novel and the movie centres around the life of a 'bohsia', it is not surprising that there are many similarities in respect of the elements associated with 'bohsia' in both the novel and the movie.

[32] What are left for comparison are similarities as in items 1a, 3, 5, 6 and 15. However, after examining and evaluating the relevant evidence on the issue, the learned judge ruled that those similarities by themselves, cannot be said to be substantial similarities that go to the root of the novel and the movie ie, the social issues surrounding the 'bohsia' and to a lesser extent, the 'mat rempit.' In the upshot, based on the findings of the learned judge, the plaintiff had failed to establish the element of objective similarity between the novel and the movie to support his claim for copyright infringement and accordingly, the plaintiff's action was dismissed with costs by the High Court.

[33] We agree with the approach adopted by the learned judge in dealing with the matter and in making the above findings. The approach was in line with the established principles dealing with copyright infringement. Clearly, the learned judge had taken pains to examine and evaluate all the relevant evidence, in the form of oral testimonies of witnesses from both sides, documents as well the exhibits tendered during trial to determine the distinct features of the subject matter in the action. The content of the novel need to be compared directly with the scenes in the movie. As an old advice goes: "Don't judge a book by its covers".

[34] As alluded to earlier, however on appeal, the Court of Appeal reversed and set aside the learned judge's findings and her whole decision. The Court of Appeal ruled that the similarities between the novel and the movie was not commonplace, unoriginal and consist of general ideas.

[35] The core of the Court of Appeal judgment is to be found in paras. [33] and [34] thereof, which we reproduce as follows:

> [33] We respectfully disagreed with the abovementioned findings of the learned Judge. On a careful comparison of the similarities enumerated in para 10 the plaintiff's statement of claim (translated in para 12 of this judgment), it is apparent that there is a substantial similarity between the plaintiff's novel and the movie that cannot be written off as merely coincidental. This shows in our considered opinion a clear lack of judicial appreciation by the learned judge.
>
> [34] While the "bohsia" phenomenon is a social ill that was prevalent in the 1990's and the issues of "mat rempit" remains a social issues till today, the similarities between the novel and the movie are so numerous and relate not just to the general theme, plot, names of characters and places, but more importantly, character traits - even specific events and relationships in the lives of the characters, that cumulatively cannot be termed as "commonplace, unoriginal or consist of general ideas". The inescapable conclusion is that the movie had copied the novel. Some of these similarities were referred to in the Statement of Claim, in particular the following:
>
> 5. Significant similarities
>
> (i) In the novel the father who is an alcoholic and a gambler rapes his own daughter and is irresponsible. Similarly, in the movie, the character of the father rapes his own daughter. He is similarly an alcoholic, a gambler and is irresponsible.
>
> (ii) Sexual scenes of the main "bohsia" character. In the novel, Anne Natasha who was drunk only recovered consciousness at 4 a.m to discover that all the "Mat rempit" had sexual relations with her. Whereas in the movie, Tasha who was a drug addict had sexual relation with all the "Mat rempit" at a rented house.
>
> (iii) In the novel, Anne Natasha attends a 'tea dance' with the intention of attempting to drink alcohol. While in the movie, Tasha goes to a disco with the same intention of attempting to drink alcohol.
>
> (iv) In the novel, Anne Natasha who does not go to school and returns home late is scolded and slapped by her parents. Anne Natasha herself had seen her own mother come out of a hotel in Bukit Bintang with a man who was not her father. In the movie, Tasha is evicted from her home by her own mother who threw out her belongings, yet her own mother brings home other men.
>
> (v) In the novel, the popular meeting place for the "bohsia" girls and their "Mat rempit" friends is around the Bukit Bintang area. Other locations include Dayabumi and the area behind the Federal Court building. Similarly, in the movie the "Mat rempit" group had got into a fight in front of Lot 10 in the Bukit Bintang area. The "Mat rempit" and "bohsia" meeting grounds are the areas in the vicinity of the Federal Court building opposite Dataran Merdeka.

[36] In para [33] of the judgment, the Court of Appeal disagreed with the learned judge's findings that the similarities are "commonplace, unoriginal, or consist of general ideas." The basis of the Court of Appeal's ruling on this issue was made "on a careful comparison of the similarities enumerated in para. 10 the plaintiff's statement of claim (translated in para. [12] of this judgment)".

[37] In para [34] of the judgment, the Court of Appeal went on to list out the significant similarities and concluded that "... the similarities between the novel and the movie are so numerous and relate not just the general theme, plot, names of characters and places, but more importantly, character tracts ... that cumulatively cannot be termed as commonplace, unoriginal or consist of general ideas"; and concluded that "the inescapable conclusion is that the movie had copied the novel."

[38] Reading both paras. [33] and [34] in the Court of Appeal's judgment, one can conclude that the Court of Appeal made the findings on similarities between the movie and the novel only "on a careful comparison of the similarities enumerated in para. 10 of the plaintiff's statement of claim." The similarities mentioned in para. [34] relate to the same similarities mentioned in para. [33] where they referred only to the statement of claim.

[39] In para. [35] of the judgment, the Court of Appeal referred to the same "above-mentioned numerous and significant similarities between the novel and the movie" and ruled as follows:

> [35] In the light of the abovementioned numerous and significant similarities between the novel and the movie, we are not persuaded by the defence of the defendant as submitted before us that the similarities pointed out are similarities in ideas, which are not protected by section 7(2A) of the CA 1987. Neither can they be termed as commonplace general ideas or mere coincidences.

[40] Apparently, the Court of Appeal in its judgment had decided to reverse and set aside the findings of fact on the issue of similarities made by the learned judge based on evaluation of evidence available during trial before her, just based on assertions of the plaintiff in his statement of claim, even though the defendants denied extensively all the similarities in their statement of defence. There is nowhere in the Court of Appeal's judgment to indicate that the Court of Appeal had examined and evaluated the evidence available as adduced by both parties during trial.

[41] As stated earlier, the issue on whether the defendants' work amounts to a substantial reproduction of the plaintiff's work depends on the facts and circumstances of the case. To repeat what Upjohn LJ in *Francis Day (supra)* case said, "this is really a question of fact and nothing else, which depends on the circumstances of each case". These determination on this issue as well as the degree of similarities between the two works are really question of fact.

[42] What we have before us in the present case is a situation where the learned judge who, with sufficient reasons, after examining and evaluating all available evidence, and who had the visual advantage of seeing and hearing the witnesses, had made specific findings of fact and that findings were later, reversed and set aside by the Court of Appeal only on the basis of the plaintiff's assertions in the statement of claim, without referring to the evidence adduced during trial. Clearly, there is no judicial appreciation of evidence on part of the Court of Appeal. Yet, in para [33] of its judgment, the Court of Appeal ruled that "This shows in our considered opinion a clear lack of judicial appreciation by the learned judge." It is our view that, what is glaring in the judgment of the Court of Appeal is that it has failed to adopt the correct approach in deciding the matter without examining and evaluating the evidence in the case. If at all the learned judge had failed to exercise judicial appreciation as claimed by the Court of Appeal, we would stress here that one "failure" cannot be remedied by another "failure".

[43] The question of objective similarity between the two works in question and its substantiality can only be determined by direct comparison between the two works. The novel needs to be read in full and the movie needs to be seen. This was done by the learned judge, but not by the Court of Appeal. The issue as to whether the elements of "commonplace, unoriginal and consist of general ideas" can be established or not is an issue of fact and circumstance of each case. Essential features such as the theme plots, character, and other-related elements must be decided based on evidence. This is to enable the court to determine whether there are similarities between the two works. If there are similarities, then the court must determine whether those similarities are substantial or not, in light of the whole features contained in the two works. Such determination can only be done after examining and evaluating all evidence available, but not by referring only to the statement of claim and pleadings. It is basic knowledge in law that statement of claim and pleadings are not evidence; thus cannot be relied upon to prove anything in an action before the court.

[44] We find support on this proposition in the case of *L Mulkh Raj Sharma v. Shanti Sroop* [1984] 1 CLJ 24; [1984] 1 CLJ (Rep) 277; [1983] 2 MLJ 396, where the Federal Court made the following observations (which we will adopt for the purpose of our judgment):

> This sole issue clearly has to be determined essentially with reference to and in the light of the facts and the circumstances surrounding, a conclusion to be arrived at on balance of probabilities. The Magistrate cannot, in our view, be said to have erred in law and to have misdirected herself if she, after hearing and seeing the witnesses, had made a conclusion or inference on the basis of the evidence before her after giving due regard to what on balance was the weight of the evidence. In that event a judge hearing an appeal should not substitute his finding for that of the Magistrate on those facts unless the conclusion arrived at by the

Magistrate was plainly wrong and any advantage which the Magistrate enjoyed by having seen and heard the witnesses was not sufficient to explain her conclusion.

There are host of authorities dealing with principles on which an appellate court should act in reviewing finding of fact, however, suffice if we refer only to the case of *Chow Yee Wah and Anor v. Choo Ah Pat*, where it was held that:

> in the face of the finding by the trial judge on the question of fact the Federal Court were only entitled to displace his conclusion if they were satisfied that his view was plainly wrong and that any advantage which he enjoyed by having seen and heard the witnesses was not sufficient to explain his conclusion.

We have in this appeal scrutinised in depth the evidence analysed by the Magistrate and we can see nothing to show that the conclusion arrived at by the Magistrate on balance of probabilities, was plainly wrong. We do not therefore see any justification for the learned Judge to displace the Magistrate's finding and substitute his own. Evidence acted upon by the learned Judge was the same evidence considered by the Magistrate in great detail. To justify the learned Judge to disturb the Magistrate's conclusion he must be satisfied that the Magistrate had failed to take proper advantage of her having seen and heard the witnesses. (see: *Yahya bin Mohd v. Chin Tuan Nam*).

[45] The above authority (*Mulkh Raj Sharma*) is sufficient to deal with the issue before us as to whether the Court of Appeal was correct in reversing and setting aside the findings made by the learned judge in the present case. In our view, and we stress, that the Court of Appeal erred in doing so; and therefore its findings as well as its decision cannot stand and ought to be set aside. As an appellate court, the Court of Appeal in this case has no justification to displace the learned judge's finding and substitute its own, especially when no evidence as adduced in court, was ever considered at all and no cogent reason given in doing so.

[46] We had the benefit of perusing the extensive and exhaustive analysis by the learned judge of the evidence that had been adduced before her in the course of the trial. She had subjected that evidence to a fair and no less meticulous judicial appreciation of the entire evidence; both the oral testimonies of the witnesses as well as the considerable documentary evidence, inclusive of the exhibits of the two works in question. We, on our part, had scrutinised all the evidence. Having done so, we found nothing to show that the findings and conclusion arrived at by her, on the balance of probabilities, were plainly wrong, to justify such findings and conclusion to be reversed and set aside by the Court of Appeal.

[47] In view of the above consideration, we answered question 2 in the affirmative - in that there is a legal duty for the court to examine and evaluate both the distinct materials being the subject matter under the claim of infringement of copyright.

[48] With the above findings, we are of the view that the learned judge was correct in her conclusion that the similarities in this case "cannot be said to be substantial similarities that goes to the root of the novel and the movie." As stated earlier, without substantial objective similarity between the novel and the movie, the first requirement or element as outlined in *Megnaway Enterprise Sdn Bhd (supra)*, following the principle adopted by Sir Rymond Evershed MR in *Purefoy Engineering Co Ltd (supra)* has not been established by the plaintiff in the present case. In the premise, we find no necessity to answer question 1, on the issue of causal connection. The issue of causal connection arises only after the issue of substantial similarity between the two works has been established.

Conclusion

[49] In the upshot, we allowed the appeal with costs. We set aside the decision of the Court of Appeal. The decision of the learned High Court Judge is affirmed and reinstated.